

REMARKS

Reconsideration of this application, as amended, is respectfully requested.

In the Official Action, the Examiner objects to the Drawings under 37 C.F.R. § 1.84(p)(4) because reference numeral "52" has been used to designate a stepper motor, a control unit, and a camera. In response, Applicants respectfully submit that the control unit is designated by reference numeral 52 in the Drawings. The specification has been amended to correctly identify the stepper motor and camera with their respective reference numerals. Accordingly, it is respectfully requested that the objection to the Drawings under 37 C.F.R. § 1.84(p)(4) be withdrawn.

In the Official Action, the Examiner rejects claims 16 and 17 under 35 U.S.C. § 102(e) as being anticipated by Japanese Patent No. JP 406141309 to Mizuno et al., (hereinafter "Mizuno"). Furthermore, the Examiner rejects claims 1-15 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,348,928 to Jeong (hereinafter "Jeong") in view of U.S. Patent No. 6,176,782 to Lyons et al., (hereinafter "Lyons").

With regard to claims 16 and 17, Applicants respectfully traverse the Examiner's rejection under 35 U.S.C. § 102(e) for at least the reasons set forth below.

Mizuno teaches a system in which a display monitors voices with one or two microphones and adjusts the direction of the display based on the detected volume of the voices. Thus, the system of Mizuno calculates a probable direction of the voices using the microphones and adjusts the angle of the display screen to face such voices.

This is very different from the present invention as recited in independent claim 16, which recites in part:

"...a control unit having speech recognition software that identifies one or more audio commands spoken by a user in the viewing region, the control unit invoking an adjustment of the orientation of the display screen based upon the identified audio commands received from the user."

Applicants respectfully submit that the Mizuno reference does not disclose or suggest such a controller.

Thus, a system having a video display screen having the features described above and as recited in independent claim 16, is nowhere disclosed in Mizuno. Since it has been decided that "anticipation requires the presence in a single prior art reference, disclosure of each and every element of the claimed invention, arranged as in the claim,"¹ independent claim 16 is not anticipated by Mizuno. Accordingly, independent claim 16 patentably distinguishes over Mizuno and is allowable. Claim 17 being dependent upon claim 16 is thus allowable therewith. Consequently, the Examiner is respectfully requested to withdraw the rejection of claims 16 and 17 under 35 U.S.C. § 103(a).

With regard to claims 1-15, Applicants respectfully traverse the Examiner's rejection under 35 U.S.C. § 103(a) for at least the reasons set forth below.

Jeong discloses a system for sensing a thermal temperature of a person watching a display and rotating the display to face such person. Lyons discloses a stationary screen that detects the motions and/or pose of a person and calculates a command corresponding to that motion or pose. The system of Lyons ^(C) carries out the command on the display screen, such as to select an icon displayed on the screen.

¹ Lindeman Maschinenfabrik GMBH v. American Hoist and Derrick Company, 730 F.2d 1452, 1458; 221 U.S.P.Q. 481, 485 (Fed. Cir., 1984).

Thus, neither Jeong nor Lyons disclose or suggest the present invention as recited in independent claim 1, which recites in part:

"...a control unit having image recognition software that identifies the user in an image generated by the image capturing device,..."

Applicants respectfully submit that neither the Jeong nor Lyons references disclose or suggest such a controller.

Furthermore, neither Jeong nor Lyons disclose or suggest the present invention as recited in independent claim 13, which recites in part:

"... the control unit invoking an adjustment of the orientation of the display screen based upon the identified gesture of the user in the image,..."

Applicants respectfully submit that neither the Jeong nor Lyons references disclose or suggest such a controller.

Independent claims 1 and 13 are not rendered obvious by the cited references because neither the Jeong patent nor the Lyons patent, whether taken alone or in combination, teach or suggest a system having a video display screen having the features described above and recited in independent claims 1 and 13. Accordingly, claims 1 and 13 patentably distinguish over the prior art and are allowable. Claims 2-12 and 14-15, being dependent upon claims 1 and 13, are thus allowable therewith. Consequently, the Examiner is respectfully requested to withdraw the rejection of claims 1-15 under 35 U.S.C. § 103(a).

Furthermore, recently the U.S. Court of Appeals for the Federal Circuit (the "Federal Circuit") restated the legal test applicable to rejections under 35 U.S.C. § 103(a) (*In re Rouffet*, 47 USPQ2d 1453 (Fed. Cir., July 15, 1998)). The Court stated:

[V]irtually all [inventions] are combinations of old elements. Therefore an Examiner may often find every element of a claimed invention in the prior art. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an Examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be "an illogical and inappropriate process by which to determine patentability." To prevent the use of hind sight based on the invention to defeat patentability of the invention, this court requires the Examiner to show a motivation to combine the references that create the case of obviousness. The Board [of Appeals] did not, however, explain what specific understanding or technological principle within the knowledge of one of ordinary skill in the art would have suggested the combination. ... To counter this potential weakness in the obviousness construct **the suggestion to combine requirements stands as a critical safeguard against hindsight analysis and rote application of the legal test for obviousness.**

In re Rouffet, 47 USPQ2d 1457-58 (Fed. Cir., July 15, 1998) (citations omitted, emphasis added).

More recently, the Federal Circuit again dealt with what is required to show a motivation to combine references under 35 U.S.C. § 103(a). In this case the court reversed the decision of the Board of appeals stating:

[R]ather than pointing to specific information in Holiday or Shapiro that suggest the combination..., the Board instead described in detail the similarities between the Holiday and Shapiro references and the claimed invention, noting that one reference or the other-in combination with each other... described all of the limitations of the pending claims. Nowhere does the Board particularly identify any suggestion, teaching, or motivation to combine the ... references, nor does the Board make specific-or even inferential-findings concerning the identification of the relevant art, the level of ordinary skill in the art, the nature of the problem to be solved, or any factual findings that might serve to support a proper obviousness analysis.

In re Dembiczak, 50 USPQ2d 1614, 1618 (Fed. Cir., April 28, 1999) (citations omitted).

Thus, from both *In re Rouffet* and *In re Dembiczak* it is clear that the Federal Circuit requires a specific identification of a suggestion, motivation, or teaching why one of ordinary skill in the art would have been motivated to select the references and combine them. The Examiner states that it would be obvious to one of ordinary skill in the art "having the teachings of Jeong and Lyons before him at the time of the invention was made to modify the automatic rotating visual display of Jeong to include the ability to judge the location of the viewers via a visual recognition system, of Lyons." (see page 3 of the Final Official Action). The Examiner continues by arguing that one would have been motivated to make such a combination "because a vision recognition system can function in some environments where the use of a heat sensing system would be unusable.

Firstly, the Examiner's reasoning for the motivation, namely, that those skilled in the art would have been motivated to combine Jeong and Lyons to modify the automatic rotating visual display of Jeong to include the ability to judge the location of the viewers via a visual recognition system, could only have been made with hindsight based on the teachings of the present disclosure. Jeong does not disclose or suggest the use of its system with any other type of recognition system, let alone an image or hand gesture recognition system and Lyons is not directed to a rotating display screen at all.

Secondly, the Examiner's reasoning for the motivation for combining the references, namely, because a vision recognition system can function in some environments where the use of a heat sensing system would be unusable, is nowhere recognized in Jeong nor does the Examiner make any showing that the art recognized such a problem.

Where a feature is not shown or suggested in the prior art references themselves, the Federal Circuit has held that the skill in the art will rarely suffice to show the

missing feature. Al-Site Corp. v. VSI International Inc., 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999) (Rarely, however, will the skill in the art component operate to supply missing knowledge or prior art to reach an obviousness judgment).

Thus, Applicants respectfully submit that the Examiner has used impermissible hindsight to reject claims 1-15 under 35 U.S.C. § 103(a). As discussed above, the Federal Circuit in *In re Rouffet* stated that virtually all inventions are combinations of old elements. Therefore an Examiner may often find every element of a claimed invention in the prior art. To prevent the use of hindsight based on the invention to defeat patentability of the invention, the Examiner is required to show a motivation to combine the references that create the case of obviousness. Applicants respectfully submit that the Examiner has not met this burden.

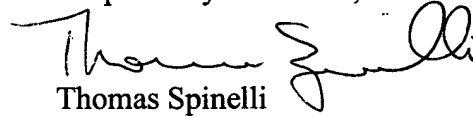
In light of the state of the law as set forth by the Federal Circuit and the Examiner's lack of specificity with regard to the motivation to combine the cited references, the applicant respectfully submits that the rejections for obviousness under 35 U.S.C. § 103(a) lack the requisite motivation and must be withdrawn.

Lastly, claim 12 has been amended to correct a typographical error therein.

In view of the above, it is respectfully submitted that this application is in condition for allowance. Accordingly, it is respectfully requested that this application be allowed and a Notice of Allowance issued. If the Examiner believes that a telephone

conference with Applicant's attorneys would be advantageous to the disposition of this case,
the Examiner is requested to telephone the undersigned.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Thomas Spinelli". The signature is fluid and cursive, with a large initial "T" and a stylized "S".

Thomas Spinelli
Registration No. 39,533

Scully, Scott, Murphy & Presser
400 Garden City Plaza
Garden City, New York 11530
(516) 742-4343
TS/cm